

**REMARKS**

Applicants respectfully request reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 2-16 and 29-43 are currently pending in the instant application. Claims 5, 9, 10, 12, 32, 36, 37 and 39 are independent in form. Applicants have amended claims 5, 9, 10, 12, 32, 36, 37 and 39 by way of this Response. Applicants submit that support for the amendments may be found throughout the specification and originally-filed claims. Applicants further submit that no new matter has been added by way of this Response.

**Rejection under 35 U.S.C. § 103**

The Examiner has rejected claims 2-8, 11-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hensley ("I'll Take Juarez") (hereinafter, "Hensley") in view of Abel et al. (U.S. Patent no. 5,289,371) (hereinafter, "Abel"), the anonymous article "Electrical," and official notice. The Examiner has rejected claim 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hensley in view of Abel and various instances of official notice. The Examiner alleges that claim 32 is parallel to claim 5; dependent claims 29-31, 33-35, 38 and 40-43 are parallel to claims 2-4, 6-8, 11 and 13-16 respectively; claim 36 is parallel to claim 9; claim 37 is parallel to claim 10; and claim 39 is parallel to claim 12, and consequently has rejected those claims on the same grounds. Applicants respectfully traverse the Examiner's rejections and submit that the Examiner has not established a *prima facie* case of obviousness and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

**I. The Examiner has not established a prima facie case of obviousness**

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that the rejections in the October 11, 2006 Office Action fail to establish the relevant teachings of the prior art relied upon and differences in the claim over the applied references by not addressing every claim limitation. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added].

By way of example only, Applicants note that the pending rejection has cited no reference nor taken Official Notice with respect to the claim limitation, "authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer," as recited in independent claims 5, 9, 10, 12, 32, 36, 37 and 39. Accordingly, Applicants submit that the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03. As none of the references cited against the pending claims discuss or render obvious at least an authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer, Applicants respectfully request withdrawal of this basis for rejection. Should the Examiner disagree and maintain the rejection, Applicants respectfully request additional clarification and specific citation from the cited references for an

"authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer," as recited in the context of the independent claims taken as wholes.

Furthermore, Applicants submit that the rejection in the October 11, 2006 Office Action has not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not treating the claims as wholes. MPEP § 2141.02 (I) states, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." [See, MPEP § 2141.02(I); original emphasis]. MPEP § 2106 (II)(C), states *inter alia*: "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Applicants submit that the pending rejection concludes obviousness of the alleged differences of the claim elements over the cited art in isolation and not in respect to the claim elements recited in each claim taken as a whole. For example, the rejection alleges,

Hensley does not disclose that conditional purchase offers include a payment identifier specifying a financial account identifier to be used to pay for the good or service upon acceptance of a conditional purchase offer by a seller, but official notice is taken that it is well known to specify financial account identifiers (see Table 3 in Abel, for example). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to have conditional purchase offers include payment identifiers specifying financial accounts, for the obvious advantage of providing evidence of a buyer's ability and willingness to pay, as well as for enabling actual payment upon the acceptance of a conditional purchase offer. (October 11, 2006 Office Action, p. 4, ¶ 1)

While the claim elements recites, "payment identifier ... to pay for said good or service upon acceptance of a conditional purchase offer by a seller ...," the Examiner has merely addressed the limitation "financial account identifier" in his rejection, and has even taken official notice for that. Applicants traverse the Examiner's invocation of official notice and object to the

Examiner's dissection of claim limitations in this manner to formulate his rejection. Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner clarify the cited references in relation to the *claims and their limitations as wholes* as prescribed, *inter alia*, by MPEP § 2106 (II)(C) and 2141.02(I).

## **II. The pending claims are patentably distinct from the cited references**

MPEP § 2142 provides that, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Applicant's contend that the Examiner has not established a *prima facie* case of obviousness based at least on the reasons given above. Nevertheless, Applicant's have amended claims 5, 9, 10, 12, 32, 36, 37 and 39 and provided the following discussion in an effort to clarify inventive aspects of the claims and to expedite further prosecution. Applicant's maintain that the claims in their prior form were in condition for allowance and reserve the right to return to that form and argue patentability at a later time.

Amended claims 5, 9, 10 and 12 recite, *inter alia*, "A processor-implemented allocation method ..." This highlights an embodiment of the claimed elements in the context of the claimed computer system implementation. Applicants submit the claimed processor-implemented method and system are not rendered obvious by the applied references, which describe face-to-face haggling in a street market and/or purchase habits of hardware consumers. Further, amended claims 5, 9, 10, 12, 32, 36, 37 and 39 recite, "a processor-implemented priority metric" that is not analogous to or rendered obvious by the whims and/or discretions of a consumer about which stores to shop from, as described in the cited references. Applicants submit that the consumer store selection allegedly described in Hensley and Electrical is manifestly customer-based, while the priority metric described in the claims allows selection of

sellers that is entirely opaque or unknown to the end-customer. The references therefore fail to teach the claim element and, accordingly, Applicants respectfully request withdrawal of the Examiner's rejection.

Although of different scope than claim 5, Applicant submits that claim 32 is patentable over the cited references for at least a similar reason as discussed above with regard to the references' deficiencies and independent claim 5. For example, claim 32 recites, inter alia:

A system . . . including . . . (3) authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer, comprising:

...

means for determining a priority schedule for the at least two sellers based on a processor-implemented priority metric and at least one seller criterion;

...

Applicant respectfully submits that at least this claim element from independent claim 32 is not taught, anticipated, or rendered obvious by the cited references, taken alone or in combination, as discussed above.

Although of different scope than claim 9, Applicant submits that claim 36 is patentable over the cited references for at least a similar reason as discussed above with regard to the references' deficiencies and independent claim 9. For example, claim 36 recites, inter alia:

A system . . . including . . . (3) authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer, comprising:

...

means for identifying one of at least two sellers as a priority seller based on a processor-implemented priority metric . . .;

...

Applicant respectfully submits that at least this claim element from independent claim 36 is not taught, anticipated, or rendered obvious by the cited references, taken alone or in combination, as discussed above.

Although of different scope than claim 10, Applicant submits that claim 37 is patentable over the cited references for at least a similar reason as discussed above with regard to the references' deficiencies and independent claim 10. For example, claim 37 recites, inter alia:

A system . . . including . . . (3) authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer, comprising:

...

means for identifying one of at least two sellers as a priority seller based on a processor-implemented priority metric . . .;

...

Applicant respectfully submits that at least this claim element from independent claim 37 is not taught, anticipated, or rendered obvious by the cited references, taken alone or in combination, as discussed above.

Although of different scope than claim 12, Applicant submits that claim 39 is patentable over the cited references for at least a similar reason as discussed above with regard to the references' deficiencies and independent claim 12. For example, claim 39 recites, inter alia:

A system . . . including . . . (3) authorization to charge said payment identifier for said good or service upon acceptance of a conditional purchase offer, comprising:

...

means for identifying one of at least two sellers as a priority seller based on a processor-implemented priority metric . . .;

...

Applicant respectfully submits that at least this claim element from independent claim 39 is not taught, anticipated, or rendered obvious by the cited references, taken alone or in combination, as discussed above.

Furthermore, Applicants submit claims 2-4, 6-8, 11, 13-16, 29-31, 33-35, 38 and 40-43, which are directly or indirectly dependent from independent claims 5 and 32, are also not taught, anticipated, or rendered obvious by the cited references, taken alone or in combination, for at least the reasons discussed above.

Accordingly, Applicant requests withdrawal of this ground of rejections.

### **CONCLUSION**

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 2-16 and 29-43, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the

opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

#### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-018. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-018.

Respectfully submitted,  
CHADBOURNE & PARKE, L.L.P.



Dated: July 28, 2008

By: /Walter G. Hanchuk/

Walter G. Hanchuk

Registration No. 35,179

Correspondence Address:

CHADBOURNE & PARKE, L.L.P.

30 Rockefeller Plaza

New York, NY 10112

212-408-5100 Telephone

212-541-5369 Facsimile